

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
	Jignesh Shah et al.	)
		)
Serial No.:	10/697,733	) Art Unit
		) 2874
Filed:	October 30, 2003	)
		)
For:	COUNTERBORE BASE MEMBER FOR	)
	FERRULE-TYPE OPTICAL CONNECTOR	)
		)
Confirmation No.:	7719	)
		)
Customer No.:	022913	)
		)
Examiner:	Juliana K. Kang	)

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop: AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed April 18, 2006 (the "Final Office Action"), Applicants respectfully request a panel review of the final rejection under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal.

Claims 6 and 14 have previously been canceled from the application leaving claims 1-5, 7-13, and 15-21 pending in the application. Claims 1-5, 7-13, and 15-21 have been finally rejected under 35 U.S.C. § 103(a) as purportedly being obvious over Applicants' Figures 1A and 1B and further in view of US 6,629,780 to Kang et al. ("*Kang*").

### **Legal and Factual Deficiencies**

#### **1. Failure to Establish That the References Teach or Suggest All the Claim Limitations**

In the Final Office Action, the Examiner has, again, failed to establish that the cited materials teach or suggest all the claim limitations of the rejected claims 1-5, 7-13, and 15-21. Particularly, the Examiner has failed to designate the particular part(s) of the references relied upon in the rejection of claims 1-5, 7-13, and 15-21 under 35 § U.S.C. 103(a).

In this regard, Applicant notes in general that “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” See, *MPEP 706*.

With regard to the repeated failure of the Examiner to specifically address the limitations of the rejected claims, Applicant submits that if the origin of teachings and motivation set forth for the proposed combinations are believed by the Examiner to be present in the cited materials, then such origin should be set forth as suggested by MPEP 2144.08 III which states, “... [w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings.” *Emphasis added*.

Finally, Applicant notes that the patent rules are in accord with the examination guidelines. For example, Rule 1.104(c)(2) provides that “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” *Emphasis added*.

Notwithstanding these requirements however, the Examiner’s rejection of claims 1-5, 7-13, and 15-21 in the Final Office Action is little more than a verbatim repetition of the same vague assertions set forth in the initial Office Action (mailed September 2, 2005), namely:

“Applicant’s admitted prior art teaches all the claimed limitations (see Fig. 1A and 1B of applicants drawing) except a recess having two different internal perimeters. Kang et al teaches inserting a fiber into an opening and further teaches having a wide opening on the side where fibers will be inserted while having a narrower opening at the point where the fibers exit makes fiber insertion easier. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wider

opening in the applicant's admitted prior art to make the insertion of the ferrule into the base easier."

*Final Office Action, page 3. Emphasis added.*

It is apparent from the foregoing that the Examiner has, in contravention of the examination rules and guidelines, failed to designate the particular part(s) of the references upon which the Examiner has relied in making the rejection. Rather than designating where in each reference each limitation of each of claims 1-5, 7-13, and 15-21 is purportedly disclosed, the Examiner has instead simply made the vague assertions that "Applicant's admitted prior art teaches all the claimed limitations (see Fig. 1A and 1B of applicants drawing) except a recess having two different internal perimeters" and that "Kang et al teaches ... having a wide opening on the side where fibers will be inserted while having a narrower opening at the point where the fibers exit ..." *Final Office Action at 3.*

As in the first Office Action, the Examiner has failed, in the Final Office Action, to even recite each of the limitations of claims 1-5, 7-13, and 15-21, much less identify where each limitation is believed by the Examiner to be disclosed in *Kang* or Figures 1A and 1B. For example, even though *Kang* includes 44 figures and 30 columns with 1,958 lines of text, the Examiner has failed to make reference to a single figure, column, or line of *Kang* in the previous Office Action. Similarly, the Examiner has failed to make reference to any one of the 27 reference numerals in Figures 1A and 1B. Applicants respectfully submit that vague assertions that all claim limitations are taught, without any reference to any particular part(s) of the materials relied upon for the rejection, fall well short of establishing that the references, when combined, teach or suggest all the claim limitations of the rejected claims.

**2. Failure to Establish Existence of Suggestion or Motivation to Combine Reference Teachings**

Not only has the Examiner failed to establish that the references, when combined, teach or suggest all the claim limitations recited in the rejected claims, but the Examiner has also failed to establish the existence of a suggestion or motivation to combine the purported teachings of the cited materials.

Applicant notes at the outset that inasmuch as the Examiner has failed to specifically refer to any particular elements of the cited materials, it is not clear what the Examiner believes to constitute the purportedly obvious combination. Nonetheless, the Examiner has asserted that "... it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wider opening in the applicant's admitted prior art to make the insertion of the ferrule into the base easier." *Final Office Action at 3. Emphasis added.*

Notwithstanding this assertion, the Examiner has neither asserted, nor established, why "mak[ing] the insertion of the ferrule into the base easier" in the device of Figures 1A and 1B would be desirable.

Instead, the Examiner offers nothing more than a conclusory statement implying that, with regard to the device of Figures 1A and 1B, “mak[ing] the insertion of the ferrule into the base easier” would be beneficial. In this regard, Applicants respectfully submit that the mere fact that a particular functionality can be implemented in a device, and Applicants make no concession in that regard, is not alone sufficient to establish that there is a suggestion or motivation to do so. See *MPEP* § 2143.01.

Finally, the Examiner has also failed to establish that the device of Figures 1A and 1B suffers from such shortcomings as could, or would, be remedied by employment of the purported disclosure of *Kang*. In the absence of any proof or evidence that the device of Figures 1A and 1B is somehow deficient in terms of the relative ease with which the “ferrule” can be inserted into the “base,” and that such deficiency could be remedied by the *Kang* disclosure, Applicants submit that the Examiner has failed to establish the existence of the requisite motivation to combine the purported teachings of Figures 1A and 1B and *Kang*.

### 3. **Failure to Answer Substance of Applicants’ Arguments**

In connection with the foregoing discussion at 1. and 2. above, Applicants note as well that in Applicants’ Paper filed February 2, 2006, Applicants traversed the rejection of the Examiner on the aforementioned bases. See, e.g., *Applicants’ Paper filed February 2, 2006 at pp. 8-10*. In the Final Office Action, however, the Examiner failed to address the arguments set forth by Applicants in Applicants’ Paper filed February 2, 2006, and instead stated:

“Applicant’s arguments filed February 2, 2006 have been fully considered but they are not persuasive. In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that the *Kang* reference does not teach the friction-fit. However, the friction fit (interference fit) is taught by the applicant’s admitted prior art.”

*Final Office Action at 3.*

Not only has the Examiner failed to establish, as outlined above, that the “admitted prior art” teaches a friction fit, but it is clear in any event from the aforementioned statement that the Examiner has failed to address the substance of the arguments set forth in Applicants’ paper filed on February 2, 2006. In this regard, Applicants note that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” *M.P.E.P.* § 707.07(f). *Emphasis added.* Insofar as the Examiner has failed to answer the substance of

Applicants' arguments, Applicants submit that the rejection of the claims is not well taken and should accordingly be withdrawn.

4. **Conclusion**

In light of the discussion set forth herein, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-5, 7-13, and 15-21, at least because even if the references are combined as the Examiner has suggested would be obvious to do, the Examiner has failed to establish that the resulting combinations include all the limitations of the rejected claims, and because the Examiner has not established the existence of a suggestion or motivation to combine the purported disclosure of the cited references.

Because the rejections set forth in the Final Office Action include a variety of legal and factual deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Moreover, in view of the foregoing remarks, Applicants respectfully request withdrawal of finality of the rejection, reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Dated this 18<sup>th</sup> day of July, 2006.

Respectfully submitted,



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